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UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kaneko, et al.

Serial No.: 09/839,539

Group Art Unit: 2651

Filed: April 23, 2001

Examiner: Wong, Kin C.

For: DISK DRIVE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

**RECORD OF TELEPHONE INTERVIEW AND RENEWED
REQUEST FOR WITHDRAWAL OF FINALITY OF REJECTION**

Withdrawal of the finality of the Office Action of October 12, 2004 is requested, together with restarting of the period for response to that Office Action. In rejecting the claims, the Office Action relies on Pennock, U.S. Patent No. 4,885,517. Pennock was first cited in an Office Action dated March 17, 2004, but was not used as a ground of rejection of the claims in the application. In response to that rejection, the claims were amended only as to form.

Attached is a copy of claim 1 as amended in the Amendment filed June 16, 2005. As can be seen, the preamble of claim 1 was amended to replace “under supply of a predetermined rating voltage of power voltage” with “under supply of a power voltage of a level equal to or smaller than a predetermined rating level.” If the disk drive apparatus was “under supply of a predetermined rating voltage,” then during such time the power voltage was “of a level equal to the predetermined rating voltage.” Later original claim 1 described the power voltage as being “smaller than said rating voltage,” and during such time the power voltage was “of a level smaller than the rating voltage.” Consequently, this amendment to the preamble did not change the scope of claim 1.

Further, the preamble is not an element of the claimed disk drive apparatus. *Kropa v. Robie*, 187 F2d 150, 88 USPQ 478 (CCPA 1951). Thus, the amendment to the preamble could not affect the scope of claim 1.

Claim 1 was also amended to explicitly recite that certain action takes place when the power voltage goes below a first voltage level smaller than the rating level and to recite that other action takes place when the power voltage goes below a second voltage level smaller than the rating level but greater than the first voltage level. Prior to that amendment, claim 1 recited that certain action takes place when the power voltage goes below the first voltage level, and that other action takes place when the power voltage is smaller the rating voltage but greater than the first voltage level.

If the power voltage is smaller than the rating voltage but greater than the first voltage level, then clearly the power voltage is below a second voltage level that is smaller than the rating level but greater than the first voltage level, perhaps only infinitesimally smaller, but nevertheless smaller. Thus, that amendment only affected the form of the claim.

Likewise, if the power voltage is smaller than the rating level but greater than the first voltage level, then the first voltage level is also smaller than the rating voltage, and so that amendment only affected the form of the claim.

Accordingly, the amendment of claim 1 did not necessitate reliance on Pennock to reject the claim.

Turning to claims 8 and 14, those claims were amended only to delete reference to the "first speed." During a telephone interview March 16, 2005, Examiner Kin C. Wong contended that this changed the scope of claims 8 and 14 because with the reference to "first speed," the

claim indicated that the head was driven, powered, or moved by inertia. *Assuming that to be so*, deletion of “at a first speed” did not change the scope of the claim. If the head is moved, whether toward the retract position or in any direction, it is moving at some speed. Whether that motion is caused by the head being driven, powered, or moved by inertia is irrelevant. Any motion takes place at some speed. Since no other speed is indicated in either claim 8 or claim 14, that is “a first speed.” Thus, with or without inclusion of the words “at a first speed” in claims 8 and 14, the head is moving “at a first speed,” and so the scope of those claims is the same with or without those words.

Clearly, deletion of “at a first speed” did not change the scope of claims 8 and 14, and so did not necessitate reliance on Pennock to reject those claims.

MPEP §707.07(g) states:

“Piecemeal prosecution should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available”. (Emphasis added.)

MPEP §706.07(a) states:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” (Emphasis added.)

Pennock was clearly a new ground of rejection that was not necessitated by Applicants’ amendment of the claims. Pennock was not submitted in an Information Disclosure Statement.

The Office Action of October 12, 2004 violates both MPEP §707.07(g) and MPEP §706.07(a). Clearly, if Pennock provides valid grounds for rejection of the claims as amended in the Amendment of June 16, 2004, then it also provided valid grounds for rejection of the claims

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prior to that Amendment. In such event, not using Pennock as one of the grounds for rejection in the March 17, 2004 Office Action, but doing so in the October 12, 2004 Office Action constitutes piecemeal prosecution.

Clearly, also, using Pennock as a ground of rejection in the Office Action of October 12, 2004 introduces a new ground of rejection that was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Accordingly, the October 12, 2004 Office Action should not have been a final rejection, and so withdrawal of the finality of the rejection is requested.

During the telephone interview of March 16, 2001, Examiner Wong contended that Pennock provided a proper basis for rejection of the amended claims. However, the issue is not whether Pennock provides a proper basis for rejection of the claims, but rather the issue is whether reliance on Pennock to reject the claims was necessitated by the amendments to the claims. As shown above, the scope of claim 1 was not changed by the amendments, and so the amendments did not necessitate reliance on Pennock.

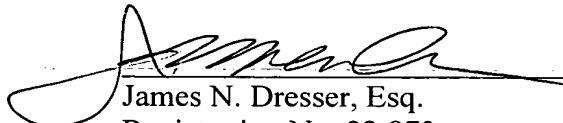
A response to the substance of the rejection will be filed in due course. Applicant is entitled to the opportunity to amend the claims, if necessary, to any extent appropriate in order to overcome this new ground of rejection, and so withdrawal of the finality of the rejection is proper. It is also requested that the period for response to the Office Action be restarted with the mailing of a paper in response to the present paper which withdraws the finality of that Office Action.

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No response, written or otherwise, was received to the Request for Withdrawal of Finality of Rejection filed December 13, 2004 until the March 16, 2005 telephone message from the undersigned attorney to Examiner Wong, which motivated Examiner Wong to call back. The courtesy of a written response to the present paper is respectfully requested. In the event the response does not withdraw the finality, it is requested that the reasoning behind not doing be clearly set forth.

Respectfully Submitted,

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1. (Currently amended) A disk drive apparatus for controlling, under supply of a power voltage of a level equal to or smaller than a predetermined rating-voltage-of power voltage level, a head drive section to position a head in a radial direction of an information recording disk and carry out a write and/or read operation of information while rotatively driving the information recording disk by a rotation drive motor, said disk drive apparatus comprising:

a forcible restoring section for controlling said head drive section to forcibly bring said head to a retract position when said power voltage goes below a first voltage level smaller than said rating level; and

a normal restoring section for controlling said head drive section to move said head toward said retract position on the basis of said power voltage ~~while~~ when said power voltage is goes below a second voltage-level smaller than said rating ~~voltage-level~~ but greater than said first voltage level.